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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/722,148

11/25/2000

Kia Silverbrook

NPP010US

3978

24011

7590

08/17/2004

SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

SINGH, SATWANT K

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/722,148

Applicant(s)

SILVERBROOK ET AL.

Examiner

Satwant K. Singh

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to because of the following informalities: The application number of the co-pending application that is referred to in the following sections is missing:

Background Art (page 4, line 5)

Best Mode of Carrying out the Invention (page 6, line 14, page 9, line 9)

Appropriate correction is required.

### ***Claim Objections***

2. Claim 10 is objected to because of the following informalities: It appears to the examiner that the claim should reference claim 2, since no selection means are listed in claim 1. Appropriate correction is required

3. Claim 12 is objected to because of the following informalities: It appears to the examiner that the claim should reference claim 11. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-4, 6-9, 11-13, and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tang et al (US 6,160,629) in view of Barrett et al. (US 5,935,262).

5. Regarding Claim 1, Tang et al teach a printing system including a printer (reads on image forming device) (col. 3, lines 44-45) for printing documents based at least in part on print data and a server (reads on controller/formatter) (col. lines 6-7) for receiving and/or generating print jobs and for transmitting print data to the printer corresponding to the print jobs, the system having a first operative mode (reads on Job Retention Option: Off or Quick Copy or Proof and Hold) (col. 5, lines 27-44) in which the server transmits print data to the printer and the printer prints documents and a second operative mode (reads on simple retention and private printing (col. 6, lines 66-67 and col. 7, lines 1-3, lines 28-30), in which the printer does not print documents and the system stores data relating to a pending print job which has not been printed (reads on allows user to download a print job to the printer disk drive without printing the document) (col. 6, lines 66-67 and col. 7, line 1)

Tang et al do not teach when the mode changes from the second mode to the first mode the system retrieves or generates an electronic summary of the pending print jobs and causes the printer to print a printed summary corresponding to the electronic summary.

Barrett et al teach outputting a network device log file. A log file is maintained which logs the image forming jobs received from the LAN and output to the image forming apparatus (col. 16, lines 1-19).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tang et al by the teaching of Barrett et al to generate an electronic summary/log of the pending print jobs corresponding to the pending jobs in the queue to allow the user to see which jobs are pending on the printer.

6. Regarding Claim 2, Tang et al disclose a system of including selection means to enable a user to select any print job on the printed summary for: printing (reads on user prints copies of the document) (col. 7, lines 11-17), or deletion (reads on a user may delete a stored job) (col. 7, lines 20-25) from the electronic summary.

7. Regarding Claim 3, Tang et al disclose a system wherein a print job selected on the printed summary for printing is printed (reads on user prints copies of the document) (col. 7, lines 11-15) and a print job selected on the printed summary for deletion is deleted from the electronic summary (reads on user may delete a stored job) (col. 7, lines 20-23).

8. Regarding Claim 4, Tang et al disclose a system wherein the print job selected on the printed summary for printing is deleted from the electronic summary after printing (reads on private print jobs are automatically deleted after the user has released the job for printing) (col. 7, lines 60-61).

9. Regarding Claim 6, Tang et al disclose a system wherein in the second mode the server stores the data relating to the print jobs and on changing from the second to the first mode the server generates the electronic summary and forwards a print job corresponding to the electronic summary to the printer (reads

on the user prints copies of the document by entering the Private/Stored Jobs Menu) (col. 7, lines 11-15).

10. Regarding Claim 7, as best understood by the language of the claim is rejected for the same reason as claim 1.

11. Regarding claim 8, Tang et al disclose a system including a user interface for changing the operative mode of the system between the first and second modes or vice versa (reads on menu selections) (col. 5, lines 24-27).

12. Regarding Claim 9, Tang et al disclose a system wherein the selection means includes a user interface on the printer (reads on Figs. 4A-4E).

13. Regarding Claims 11 and 16, as best understood by the language of the claims are rejected for the same reasons as claim 1.

14. Regarding Claim 12 and 18, as best understood by the language of the claims are rejected for the same reasons as claim 3.

15. Regarding Claim 13 and 19, as best understood by the language of the claim is rejected for the same reasons as claim 4.

16. Regarding Claim 15, as best understood by the language of the claim is rejected for the same reasons as claim 6.

17. Regarding claim 17, as best understood by the language of the claim is rejected for the same reasons as claim 2.

18. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett et al as applied to claim 1 above, and further in view of Yagita (US 6,654,137).

Tang et al fail and Barrett et al fail to teach a system wherein each entry in the electronic summary is retained for a selected period of time after entering the first mode from the second mode unless the respective entry is deleted beforehand and at the end of the selected period any entries in the electronic summary are deleted.

Yagita teaches a timer function for providing a timeout notification when the specified time is reached. In the case of a timeout, the server issues a request for deleting the corresponding job (Fig. 15, S1322, S1323, S1336) (col. 13, lines 21-26, col. 14, lines 7-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tang et al by the teaching of Yagita to add the timer function to the printing system to delete old printing jobs and conserve memory space in the server.

19. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett et al as applied to claim 1 above, and further in view of Ogawa et al (US 6,704,431).

Tang et al and Barrett et al fail to teach a system wherein the pages are printed with coded data indicative of a print selection and a delete selection for each entry and the selection means includes a sensor for sensing the coded data.

Ogawa et al teach a digital watermarking system with includes a means for embedding and reading a digital watermark (Fig. 1) (col. 6, lines 25-37).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tang et al by the teaching of Ogawa et al to add the digital watermarking embedding and reading means to enable the user to select whether to print or delete the print job.

20. Claims 14 and 20, as best understood by the language of the claims are rejected for the same reasons as claim 5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (703) 306-3430. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



*Satwant Singh*

sks

Satwant K. Singh  
Examiner  
Art Unit 2626

*[Signature]*  
MARK WALLERSON  
PRIMARY EXAMINER